

REMARKS

The Office action dated July 2, 2004, has been carefully considered. Independent claim 1 has been amended as discussed in greater detail below. Claim 4 has been canceled without prejudice. The dependencies of claims 5-7 and 9 have been amended in view of the cancellation of claim 4. The format of claims 6 and 12 has been amended without affecting the scope of the claims. No new matter has been added by these amendments. Reconsideration and allowance of the present application in view of the above amendments and the following remarks are respectfully requested.

Applicant notes with appreciation the Examiner's indication that claims 4-9 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Independent claim 1 has been amended to include allowable subject matter from claim 4, and thus is similar in scope to claim 4 rewritten in independent form, and is allowable as amended. Claim 4 has accordingly been canceled. Claims 5-7 and 9 have been amended to depend from claim 1 in view of the cancellation of claim 4, and remain allowable.

Claim Rejections Under 35 U.S.C. § 102(b):

Claim 1 has been rejected under 35 U.S.C. § 102(b) as being anticipated by United States patent No. 6,105,650 to Manusch et al. ("Manusch '650"). Claims 1 and 15 have been rejected under 35 U.S.C. § 102(b) as being anticipated by United States patent No. 4,853,074 to Manusch et al. ("Manusch '074"). Claims 1-3, 10, 15, and 16 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Japanese Patent No. JP 11-157290 to Kobayashi ("Kobayashi"). These rejections are respectfully traversed.

As noted above, independent claim 1 has been amended to recite allowable subject matter of claim 4, and thus is allowable. Accordingly, withdrawal of these rejections and reconsideration and allowance of independent claim 1 and all claims depending therefrom are respectfully requested.

Claim Rejections Under 35 U.S.C. § 103(a):

Claims 11 and 12 have been rejected under 35 U.S.C. § 103(a) as being obvious over Manusch '650 or Manusch '074 or Kobayashi as applied to claim 1, and further in view of United States patent No. 5,281,298 to Poisson et al. ("Poisson"). Claim 13 has been rejected under 35 U.S.C. § 103(a) as being obvious over patent '650 or patent '074 or Kobayashi as

applied to claim 1, and further in view of United States patent No. No. 5,772,840 to Morinaga ("Morinaga"). Claim 14 has been rejected under 35 U.S.C. § 103(a) as being obvious over patent '650 or patent '074 or Kobayashi as applied to claim 1, and further in view of Kobayashi. Claims 17 and 18 have been rejected under 35 U.S.C. § 103(a) as being obvious over patent '650 or Kobayashi as applied to claim 1, and further in view of Morinaga. These rejections are respectfully traversed.

As discussed above, claim 1 has been amended to recite allowable subject matter from claim 4. Accordingly, claim 1, and all claims depending therefrom, including claim 11-14, 17, and 18, are allowable. Withdrawal of these rejections and reconsideration and allowance of claims 11-14, 17, and 18 are respectfully requested.

This rejection is respectfully traversed.

New Claims:

New independent claim 19 recites a hand-held device for transferring a file onto a substrate, the device having a housing and an application member with first and second application edges. Independent claim 19 specifies that the height of the second application edge is greater than the cross-sectional dimension of the first application edge or a shaft of the application member, and that the second application edge has a wedge-shaped cross-sectional shape. Support for this amendment can be found, for example, at paragraph [0024] of the originally-filed specification. It is respectfully submitted that none of the references of record shows or suggests a device with an application member with first and second edges as defined in independent claim 19. Accordingly, independent claim 19 is allowable, notice of which is respectfully requested.

New independent claim 20 has been added to provide an additional independent claim having a scope different from independent claim 1, and defining the present invention over the prior art of record by specifying that "said first and second application edges extend across approximately the entire width of said application member." Support for this claim may be found, for example, in Figure 6 as originally-filed, and paragraph [0024] of the originally-filed specification. It is noted that the elements the Examiner identified as a "second application edge" in Manusch '650 and Manusch '074 do not have a mid-central plane transverse to a mid-central plane of the elements the Examiner identified in these patents as a "first application edge." Because none of the cited references has a second application edge transverse to a first application edge and that "extends across approximately

the entire width of said application member,” independent claim 20 is allowable. A notice to that effect is respectfully requested.

New claims 21- 23 recite subject similar to the subject matter of claims 2, 10, and 15, but depend from allowable new independent claim 20 and thus are also allowable. A notice to that effect is respectfully requested.

New independent claim 24 has been added to provide an independent claim reciting subject matter of original claims 1 and 14 and more particularly pointing out the location of the guiding web to more distinctly claim the inventive features defining the claimed invention over the cited references. Because none of the cited references shows or suggests a second application edge offset backwards in relation to a first application edge and having at least one guiding web as recited in new independent claim 24, new independent claim 24 is allowable. A notice to that effect is respectfully requested.

Support for new claims 25 and 26 may be found, for example, at paragraph [0027] of the originally-filed specification. New dependent claims 25 and 26 depend from allowable claim 24 and thus are also allowable. A notice to that effect is respectfully requested.

Conclusion:

The above amendments are fully supported by the originally-filed specification. No new matter has been introduced. For the above reasons, reconsideration and allowance of independent claim 1 and all claims depending therefrom, as well as new claim 19-25 are respectfully requested. Should the Examiner not agree all claims are allowable, then a personal or telephonic interview with the undersigned is respectfully requested to discuss any remaining issues and to accelerate allowance of the present application.

Fees due for additional claims are submitted herewith. No additional fees are believed to be due for this amendment. Should any additional fees be required, please charge such fees to Jones Day Deposit Account No. 16-1150.

Respectfully submitted,

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